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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,848	11/17/2000	Thomas J. Perkowski	100-058USA000	9618

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Thomas J. Perkowski, Esq.
Thomas J. Perkowski, Esq., P.C.
Soundview Plaza
1266 East Main Street
Stamford, CT 06902

EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,848

Applicant(s)

PERKOWSKI, THOMAS J.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 405-417 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 405-417 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/4/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 9/12/05.

Information Disclosure Statement

The information disclosure statement filed 11/4/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Only some of the references cited have been initialed and considered. As noted of the returned copy of the PTO-1449, one publication was cited without a copy of the document and it was cited without a date. One publication was not considered because the copy was faulty (right margin was cut off). None of the foreign documents were considered because full copies were not provided. None of the PCT applications were considered because only search reports were submitted; not full copies of the published applications.

Claim Objections

2. Claim 408 is objected to because of the following informalities:
 - Claim 408(ii), "production" should be replaced by --product.--
 - Claim 410 --as--should apparently be inserted after "function."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 405-417 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 405, the use of and/or renders the claim scope indefinite.
- Claim 406 recites a 4th subsystem, yet such a subsystem is already presented in the base claim.
- Claims 407, 408, 411, 415, there is no antecedent basis for the link/link structure.
- Claim 408 (iii), there is no antecedent basis for the "node."
- Claim 409, there is no antecedent basis for "these components."
- Claims 408, 409, 412, 415, 417, the phrases "e.g.", "i.e.", "such as" and "etc." render the claim indefinite because it is unclear whether the limitation(s) associated with the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- Claim 408, the phrase "if applicable" renders the claim scope indefinite as it is unclear whether such a limitation is positively required and what defines the applicability of such a feature.
- Claim 409, the meaning of "UPS/SM/SD" is unclear.
- Claim 413, there is no antecedent basis for "trading partner."

- Claims 415, 416, there is no antecedent basis for the keys.
- Claim 417, there is no antecedent basis for the UPN, TM and PD.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 405-417 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).**

7. Regarding claims 405, 410, 412, 415-417, Stern teaches systems and methods for providing networked, in-store kiosks that can be used to deliver product information and advertisements. A centralized server (NMC/NOC 12/20) receives various types of content (ads, information, audio, video, etc) and makes the content available to various stores [fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard and light pen. The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A consumer can scan the UPC barcode of a product at the kiosk and receive advertising and other information about the product [6:46-50, 7:14-17, 27-32, 48-50] which provides a positive brand experience. Applicant claims "UPN/TM/PD/URL links" and provides language describing what each acronym stands for, yet no structure is positively claimed other than "links". However, claim 410 subsequently sets language requiring indexing/linking/association between the information resource(s) and its

UPN/TM/PD. The UPN/TM/PD/URL portion of the language is not taken to otherwise positively limit the links. Stern teaches that the central database provides a UPC-indexed database of products that stores the relationship (via the tblUPCmaster table) between the UPC codes and the associated content (ads, information, audio, etc) associated with that product [8:10-25]. The UPC codes of Stern are taken to be equivalent to applicant's UPN in that they both provide an item identifier to be used for database lookups to retrieve and deliver advertising and item information. Stern teaches that functionality is provided to input ads/information into the system [6:1-34] which is taken to represent programming of the various information modes. Stern teaches that a management user interface is provided for viewing and creating the tables in the database which determine the content and content delivery mechanisms for the kiosks. It is unclear whether management workers must interface the system locally or remotely. However, Stern teaches a distributed system of complex subsystems which communicate over various networks including the Internet and it would have been obvious to one of ordinary skill at the time of the invention to have provided the management user interface as a web-enabled interface in order for any remotely located manager to access and program the system. The display of ads and information to the requesting user about the requested item is taken to provide a virtual kiosk that displays advertisements and information which are taken to promote the item. Any web page displaying any content about the requested item is taken to be a "virtual kiosk." Durst, Jr. et al also teaches a means for a consumer to scan a barcode (at a kiosk [8:1-3]) in order send a request to a centralized server for more information

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about the item scanned. Durst, Jr. et al teaches that the item identification/barcode is scanned into the a web browser and sent to the server. The server links the user to the URL of the associated information [3:15-30, 66-67]. Although any advertisement content delivered through an advertising mode is taken to promote the item advertised, therefore providing a promotion and promotion mode, Durst, Jr. et al teaches product descriptions as well as product promotions [col 23 lines 7-29]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a mode for displaying product promotions as well Stern's displaying advertising mode and product information mode in order to provide more brand awareness and encourage the consumer to purchase a particular brand.

8. Regarding claims 406-409, 411, the system of Stern is taken to provide management with a means (subsystem) for creating the necessary links/indexes/keys of UPN/TM/PD to the associated content in the databases. Official Notice is taken that URL links are well known to include icons and/or link text. It would have been obvious to one of ordinary skill at the time of the invention to have labeled the provided links with such items in order to describe the link to the user for clarity. Further, Stern teaches providing ads, audio, video and information about the item. Durst, Jr. et al teaches providing product and other types of information about products. It would have been obvious to one of ordinary skill at the time of the invention to have returned a list of URL links to the user when the product requested is associated with plural content files (ads, promotions, information, warranty, etc), so that the user may choose which content to review.

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9. Regarding claims 413, 414, Stern teaches that a user seeking information on a scanned product may be automatically shown a series of information including advertising and information about related products as well as the requested information [7:26-35]. Stern also teaches that video information may be provided. This is taken to meet the "rich media" limitation.

Response to Arguments

10. Applicant presents no arguments why even a single claimed or disclosed feature are allowable over the applied art, nor provides any argument whatsoever why the previously applied art could not be used again. Applicant has submitted entirely new claims which are rejected for the reasoning above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc